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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,693	09/11/2000	Sehat Sutardja	MP0062	5047

23624 7590 02/23/2005

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EXAMINER

FLANDERS, ANDREW C

ART UNIT PAPER NUMBER

2644

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/659,693

Applicant(s)

SUTARDJA, SEHAT

Examiner

Andrew C Flanders

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 and 95-172 is/are pending in the application.
- 4a) Of the above claim(s) 24, 27 and 113 - 168 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 23, 25, 26, 28 - 48, 95 - 112 and 169 - 172 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 23, 25, 26, 28 – 48, 95 – 112, and 169 – 172 are drawn to a media player with playback details, classified in class 700, subclass 94.
 - II. Claims 24, 27 and 113 – 168 are drawn to a media player with power saving techniques, classified in class 365, subclass 227.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the media player will operate as claimed without the power saving details. The subcombination has separate utility such as power conservation in any data access system.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Scott Harris on 24 January 2005 a provisional election was made without traverse to prosecute the invention of I, claims 1 – 23, 25, 26, 28 - 48, 95 – 112 and 169 - 172. Affirmation of this election must be made

by applicant in replying to this Office action. Claims 24, 27 and 113 – 168 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20, 47 and 95 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang (U.S. 6,119,091).

Regarding claims 20, 47 and 95, Huang discloses a multimedia device that includes a storage device 216 which stores compressed media data. Huang further discloses a 'processor', which includes discrete hardware elements comprising of 202, 204, 206, 208, 210, 220, 222, 224, 226, 228 and 230 (see figure 2) wherein the 'processor' retrieves the media data stored on the storage device 216, via the read head 220 controlled by the DSP 210. Huang further discloses a memory 204 to store the data retrieved by the 'processor'. Huang further discloses the a decoder 228 which is an element included in the processor that decompresses the data stored in memory 204. Huang further discloses an output circuit (outputs from the decoder 228) to output the

decompressed media from the 'processor'. Huang further discloses D/A converter 236 for converting the decompressed signal to an analog signal for output. Huang further discloses the DSP 210 element acts as a controller for the read/write components of the system (col. 4 lines 45 -47). Huang further discloses a read head 220, which reads on a read channel to read the data from the storage device 216 which is responsive to the controller 210 (see figure 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 19, 28 – 46, 97 – 102, and 106 – 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6,119,019) in view of Dewhurst (U.S. Patent Application Publication 2002/0019925).

Regarding claims 1, 11, 28, and 38, Huang et al. (hereinafter, "Huang") discloses a multimedia device that includes a storage device 216 which stores compressed media data. Huang further discloses a 'processor', which includes discrete hardware elements comprising of 202, 206, 208, 210, 220, 222, 224, 226, 228 and 230 (see figure 2) wherein the 'processor' retrieves the media data stored on the storage device 216, via the read head 220 controlled by the DSP 210. Huang further discloses a memory 204 to store the data retrieved by the 'processor'. Huang further discloses the a

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decoder 228 which is an element included in the processor that decompresses the data stored in memory 204. Huang further discloses an output circuit (outputs from the decoder 228) to output the decompressed media from the 'processor'. Regarding claims 2, 12, 29, 39, 50, 60, 77 and 87, Huang further discloses the memory 204 synchronous dynamic random access memory (SDRAM) (col. 3 lines 3638). Regarding claims 3,13, 30, 40, 51, 61, 78 and 88, Huang further discloses the 'processor' receives input signals from, for example, a television tuner or some other external device (col. 3 lines31 32), wherein an interface for receiving signals between the 'processor and external component is inherently taught shown by receiving inputs and outputs of audio and video to the 'processor'. Huang does not disclose a programmable processor. Dewhurst discloses FPGAs are now widely used to implement many digital functions (paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to take Huang's discrete digital elements and implement them on an FPGA as taught by Dewhurst. One would have been motivated to do so to make things smaller and more compact.

Regarding claims 2, 12, 29 and 39, Huang further discloses the memory 204 synchronous dynamic random access memory (SDRAM) (col. 3 lines 36-38) .

Regarding claims 3,13, 30 and 40, Huang further discloses the 'processor' receives input signals from, for example, a television tuner or some other external device (col. 3 lines 31-32), wherein an interface for receiving signals between the 'processor and external component is inherently taught by receiving inputs and outputs of audio and video to the 'processor'.

Regarding claims 4, 14, and 31, Huang further discloses a 'processor, which includes discrete hardware elements comprising of 202, 204, 206, 208, 210, 220, 222, 224, 226, 228 and 230 (see figure 2) wherein the 'processor' controls the storage device 216; via the read head 220 controlled by the DSP 210 as well as decompresses the media, via decoder 228 which is stored in memory 204 and therefore reads on the claimed limitation.

Regarding claims 5, 32, and 41, Huang further discloses a 'processor', which includes discrete hardware elements comprising of 202, 204, 206, 208, 210, 220, 222, 224, 226, 228 and 230 (see figure 2) wherein the 'processors controls the storage device 216, via the read head 220 controlled by the DSP 210 as well as decompresses the media, via decoder 228 which is stored in memory 204. Huang further discloses the DSP 210 element acts as a controller for the read/write components of the system (col. 4 lines 45 - 47). Huang further discloses a read head 220, which reads on a read channel to read the data from the storage device 216 which is responsive to the controller 210 (see figure 2).

Regarding claims, 6, 15, 33 and 42, Huang further discloses a 'processor', which reads on a digital signal processor, decompresses the media data stored in memory 204 via the decoder 228 (see figure 2).

Regarding claims 7,16, 34 and 43, Neither Huang nor Dewhurst disclose storing a process for decompressing the compressed data. However, Examiner takes official notice that computer systems often include the necessary decoding software in memory. If the desired process is not already included, necessary decoding software

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can be retrieved directly from the disk for the computer to load the software to its system memory, as it is well known in the art that the decoding software may be accessed directly from the system's memory or retrievable from either the disk itself or even downloaded from the internet. Therefore it would have been obvious for one of ordinary skill in the art to provide the decoding software in the digital processor of Huang for the purpose of being able to retrieve data from any of those locations.

Regarding claims 8, 17, 35 and 44, Neither Huang nor Dewhurst disclose retrieving the process for decompressing. Huang discloses the 'processor' controls the storage device 216, via the read head 220 controlled by the DSP 210 (col. 4 lines 46 67). Therefore, when the DSP determines the type of compression format necessary, the software will be retrieved from the system's memory if available. However, examiner takes official notice that If it is not available on the system, it would be obvious for one of ordinary skill to have provided the other well known locations of decoding software, which include being retrieved from the disk's storage or from the Internet. The DSP 210 then sends the information to the decoder 228 for necessary decompression.

Regarding claims 9, 18, 36 and 45, Huang further discloses the 'processor' receives media data from, for example, a television tuner or some other external device (col. 3 lines 31- 32), Huang inherently teaches an interface since the media data is to be transferred from the external device and to be stored on the storage device 216. An interface must have been used for the transmission of a signal.

Regarding claims 10, 19, 37 and 46, Huang further discloses inputting the signal into the 'processor' via the encoder 202 wherein the encoder provides

compression of the digital audio and video inputs (col. 3 lines 62- 63 and see figure 2). Huang further discloses the compressed signals are stored on the storage device 216 (col. 4 lines 56- 58 and see figure 2).

Regarding claims 97, 100, 106 and 109, Huang further discloses the device 102 accepts multimedia discs in the drive 104 wherein the disc reads on the storage device 216.

Regarding claims 98, 101, 107 and 110, Huang further discloses the multimedia disk 216 which reads on the storage device and thus reads on all the claimed limitations, which include an optical disk, magnetic disk, CD ROM, CDR and CDRW).

Regarding claims 99, 102, 108 and 111, Huang further discloses the device 102 accepts multimedia discs in the drive 104 wherein the disc reads on the storage device 216. Huang further discloses the DSP 210 element acts as a controller for the read/write components of the system (col. 4 lines 45 47) and thus controls the storage device/hard disk and therefore is a hard disk controller.

Regarding claims 112, Huang further discloses the device 102 accepts multimedia discs in the drive 104 wherein the disc reads on the storage device 216. Huang further discloses the DSP 210 element acts as a controller for the read/write components of the system (col. 4 lines 45 -47) and thus controls the storage device/hard disk and therefore is a hard disk controller.

6. Claims 21 – 23, 25, 26, 48, 96, 103 – 105 and 169 – 170 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6,119,019).

Regarding claims 21, 48 and 96, Neither Huang nor Dewhurst disclose storing a process for decompressing the compressed data or retrieving the process for decompressing. However, examiner takes official notice that computer systems often include the necessary decoding software in memory. If the desired process is not already included, necessary decoding software can be retrieved directly from the disk for the computer to load the software to its system memory, as it is well known in the art that the decoding software may be accessed directly from the system's memory or retrievable from either the disk itself or even downloaded from the internet. Therefore it would have been obvious for one of ordinary skill in the art to provide the decoding software in the digital processor of Huang for the purpose of being able to retrieve data from any of those locations.

Huang further discloses the 'processor' controls the storage device 216, via the read head 220 controlled by the DSP 210 (col. 4 lines 46-67). Therefore, when the DSP determines the type of compression format necessary, the software will be retrieved from the system's memory if available. The Examiner takes official notice that if it is not available on the system, it would be obvious for one of ordinary skill to have provided the other well known locations of decoding software, which include being retrieved from the disk's storage or from the Internet. The DSP 210 then sends the information to the decoder 228 for necessary decompression.

Regarding claim 22, it is interpreted and thus rejected for the same reasons as set forth above in claim 1. Since claims 22 and 70 disclose a method, which corresponds to, the apparatus of claim 1; the method is obvious in that it is simply

provides functionality for the structure of claim 1. Implementing these features on a single chip, as is obvious as shown in claim 1, allows the same circuit to retrieve and decompress.

Regarding claim 23, it is interpreted and thus rejected for the same reasons as set forth above in claim 3. Since claims 23 and 71 disclose a method, which corresponds to, the apparatus of claim 3; the method is obvious in that it simply provides functionality for the structure of claim 3.

Regarding claim 25, it is interpreted and thus rejected for the same reasons as set forth above in claim 8. Since claim 8 discloses a method, which corresponds to, the apparatus of claim 8; the method is obvious in that it simply provides functionality for the structure of claim 8.

Regarding claim 26, Huang discloses everything claimed as applied above (see claims 22 and 70). Huang further discloses inputting the signal into the 'processor' via the encoder 202 wherein the encoder provides compression of the digital audio and video inputs (col. 3 lines 62 63 and see figure 2)._ Huang further discloses the compressed signals are stored on the storage device 216 (Col. 4 lines 56 58 and see figure 2).

Regarding claims 103, Huang further discloses the device 102 accepts multimedia discs in the drive 104 wherein the disc reads on the storage device 216. Huang further discloses the DSP 210 element acts as a controller for the read/write components of the system (col. 4 lines 45 -47) and thus controls the storage device/hard disk and therefore is a hard disk controller.

Regarding claim 104, Huang further discloses the device 102 accepts multimedia discs in the drive 104 wherein the disc reads on the storage device 216.

Regarding claim 105, Huang further discloses the multimedia disk 216 which reads on the storage device and thus reads on all the claimed limitations, which include an optical disk, magnetic disk, CD ROM, CDR and CDRW).

Regarding claims 169 - 172, Huang discloses a multimedia device that includes a storage device 216 which stores compressed media data. Huang further discloses a 'processor', which includes discrete hardware elements comprising of 202, 204, 206, 208, 210, 220, 222, 224, 226, 228 and 230 (see figure 2) wherein the 'processor' retrieves the media data stored on the storage device 216, via the read head 220 controlled by the DSP 210. Huang further discloses a memory 204 to store the data retrieved by the processor. Huang further discloses a decoder 228, which is an element, included in the processor that decompresses the data stored in memory 204. Huang further discloses an output circuit (outputs from the decoder 228) to output the, decompressed media from the 'processor'. Huang does not disclose transferring portions of the selections. However examiner takes official notice that it would have been obvious for one of ordinary skill in the art to transfer any amount of data desired to the memory. For example, the user could transfer into memory the contents of the entire disk or of just one or two songs if so desired for output to the listener wherein the user could continue to transfer more for example, one more song or the remaining contents of the disk.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 1 - 23, 25, 26, 28 – 48 and 95 - 112** are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 - 10 of copending Application No. 10/184,302. Although the conflicting claims are not identical, they are not patentably distinct from each other because any such portable device can be carried anywhere, for example, it can be transported in a briefcase, pocket, and vehicle to name a few. Any such portable media device as discussed above are well known to be connected and have operation in a vehicle, even if it is merely to connect for power.

9. **Claims 1 - 23, 25, 26, 28 – 48 and 95 - 112** are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 - 5, 20 - 23, 38 - 41, 56 - 59 and 74 - 85 of copending Application No. 10/184,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because any such portable device can be carried anywhere, for

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example, it can be transported in a briefcase, pocket, and vehicle to name a few. Any such portable media device as discussed above are well known to be connected and have operation in a vehicle, even if it is merely to connect for power.

10. **Claims 1 - 23, 25, 26, 28 - 48 and 95 - 112** are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 - 10, 26 - 34, 50 - 53, of copending Application No. 10/184,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the interface is inherently taught via input and output circuits are being applied wherein data is being directed to and from the system. Various types of interfaces are well known depending on port capabilities and necessities to the system environment.

This is a provisional obviousness type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed 24 September 2004 have been fully considered but they are not persuasive.

Applicant states the following:

“Specifically, claim 1 has been amended to recite a programmable processor. That programmable processor is programmed to both receive media data, and also to decompress the media data. In this way, the some device: here the programmable processor does two different things. This compares with Huang which uses two separate devices for doing these two different functions. Because the prior art uses two different devices for doing these two different functions, the prior art would require more real estate on any substrate that holds the devices, as compared with claim 1. Hence, an advantage of claim 1 is that of saving on substrate real estate.”

Examiner has noted this argument and considers it moot in light of the new rejection.

Applicant also states:

“In addition, there may be time during operation when the system is not both reading and decoding at the same time. Therefore, this leads to the unexpected advantage that the same device can retrieve and decode without sacrificing performance to the extent that might be expected, and uses less energy than might otherwise be expected.”

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the unexpected advantage that the same device can retrieve and decode without sacrificing performance to the extent that might be expected and used less energy than might otherwise be expected) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also states:

“Huang does not teach or suggest this feature. Huang teaches a D8P 210 which fetches the data, and a separate media decoder 228 that decodes the data. Another words, as discussed above, two separate devices are used to retrieve and decode the data in Huang.”

Examiner has noted this argument and considers it moot in light of the new rejection.

Applicant also states:

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“Specifically, claim 5 specifies that processor which does all of these functions is on a single integrated circuit. Nowhere does Huang teach or suggest such a single integrated circuit.”

In response to applicant's arguments, the recitation a single integrated circuit has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant also states:

“Claim 7 specifies that the storage device stores the process that carries out the decompression of the compressed data. This is again nowhere taught or suggested by the cited prior art. Moreover, this produces the advantage that a general-purpose media decoder can decompress any compressed data, since the decompression process is stored in the storage device.”

Examiner has noted this argument and considers it moot. Examiner acknowledges the prior art does not explicitly disclose storing the processes that carries out the decompression of the compressed data. However as the rejection states, “computer systems often include the necessary decoding software in memory.” Huang teaches of Multimedia decoder (listed in the rejections). It is obvious that this decoder operates on the data and decodes it according to a stored process.

Applicant also states:

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"Claim 8 specifies a determined decompression routine being stored on the disk, and retrieving that process based on a determined protocol. This is in no way taught or suggested by the cited prior art."

Examiner has noted this argument and considers it moot. As stated in the rejection, the DSP determines the type of compression format necessary. As is common within DVD players, various audio compression formats are present (i.e. AC3 or DTS) on many commercially available DVDs. As stated before it would have been obvious to one of ordinary skill in the art to provide the proper decoding software and thus the rejection stands.

Applicant also states:

"Claim 11 specifies a programmable processor which is programmed to retrieve media data and is also programmed to decompress the media data. This structure, where the same programmable processor does both retrieve and decompress, is in no way taught or suggested by the prior art, and should be allowable."

Examiner has noted this argument and considers it moot in light of the new rejection.

Applicant also states:

"Claim 20 specifies an integrated circuit to control and decode data from a storage device. This includes, as part of the integrated circuit, a digital signal processor for controlling the storage device, along with a storage controller, and that the digital signal processor includes a decoder that decompresses the media data that has been stored, and that all of this is all on one chip. This is in no way~ taught or suggested by Huang, and should hence be allowable."

In response to applicant's arguments, the recitation a single integrated circuit has not been given patentable weight because the recitation occurs in the preamble. A

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preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant also states:

“Claim 21 defines subject matter which is allowable for similar reasons to those discussed above with respect to claim 8.”

Examiner has noted this argument and considers it moot for the same reasons regarding the arguments pertaining to claim 8.

Applicant also states:

“Claim 22 specifies that the same circuit is used for both the retrieving and the decompressing of media data, and hence claim 22 should be allowable for similar reasons to those discussed above along with the claims that depend therefrom.”

Examiner has noted this argument and considers it moot in light of the new rejections.

Applicant also states:

“Claim 25 defines stored in the process for decompressing compressed data, determining the compression format, and retrieving the compression format. This is in no way taught or suggested by the cited prior art, for the reasons stated above.”

Examiner has noted this argument and considers it moot for the same reasons regarding the arguments pertaining to claim 8.

Applicant also states:

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“Claim 28 defines a programmable processing means that is programmed for retrieving media data and also is programmed to decompress media data. This is in no way taught or suggested by the cited prior art, and should be allowable for similar reasons to those discussed above.”

Examiner has noted this argument and considers it moot in light of the new rejections.

Applicant also states:

“The dependent claims should also be allocable, with claim 32 defining a single integrated circuit”

Examiner has noted this argument and considers it moot for the same reasons regarding the arguments pertaining to claim 5.

Applicant also states:

“Claim 34 defining that the storage means stores the process for decompressing”

Examiner has noted this argument and considers it moot for the same reasons regarding the arguments pertaining to claim 7.

Applicant also states:

“Claim 35, for example, defining that a process is retrieved based on a determined compression format.”

Examiner has noted this argument and considers it moot for the same reasons regarding the arguments pertaining to claim 8.

Applicant also states:

“Claim 38 has been amended to recite that the processing means uses the same circuit for controlling the storage means and also for decompressing media data stored in the storage means. Therefore, claim 38 should be allowable along with the claims which depend therefrom.”

Examiner has noted this argument and considers it moot in light of the new rejections

Applicant also states:

"Claim 41 specifies a single integrated circuit. Claims 43 and 44 define Storing processes for decoding."

Examiner has noted this argument and considers it moot, Claim 41 for the reasons regarding the arguments pertaining to claim 5, Claim 43 for the reasons regarding the arguments pertaining to claim 7, and Claim 44 for the reasons regarding the arguments pertaining to claim 8.

Applicant also states:

"Claim 47 specifies an integrated circuit and should hence be allowable along with claim 48 which depends therefrom, for at least the reasons discussed above"

Examiner has noted this argument and considers it moot, Claim 47 for the reasons regarding the arguments pertaining to claim 5, Claim 48 for the reasons regarding the arguments pertaining to claims 7 and 8.

Applicant also states:

"Claim 95 defines an integrated circuit which should be allowable for reasons discussed above."

Examiner has noted this argument and considers it moot for the reasons regarding the arguments pertaining to claim 5.

Applicant also states:

"In addition, however, claim 95 defines that the digital signal processing means converts the signal into an analog signal, and should be additionally allowable."

Examiner has noted this argument and considers it moot. As stated in the rejection, Huang discloses a D/A converter (i.e. a digital signal processing means that converts the signal into an analog signal).

Applicant also states:

"The claims that depend from claim 95 should be additionally allowable. For example, claim 96 should be allowable for reasons discussed above with respect to claim 8."

Examiner has noted this argument and considers it moot for the reasons regarding the arguments pertaining to claim 8.

Applicant also states:

"Independent claims 169 – 172 are directed to the user obtaining "first portions" of the media data, allowing the user to select, and then getting that selection. This enables a preview like function. (These claims do not recite a processor that both retrieves and decompresses the media data.) Huang does not teach this. This preview-like function is much more than merely 'transfers any amount of data', as alleged by the rejection."

"The rejection states that Huang teaches and enables transferring 'any amount of data'. However, this is much more than simply enabling transfer of any amount of data. According to claim 169, the processor transfers first portions, and allows a user to select one of those selections, and enables the processor to retrieve the remaining portion of that selection. This is in no way taught or suggested by the cited prior art and should be allowable thereover. Claims 170, 171, and 172 define analogous limitations, and should also be allowable for similar reasons to those stated above."

Examiner has noted this argument and considers it moot. As stated in the rejection "It would have been obvious for one of ordinary skill in the art to transfer any

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amount of data desired to the memory. For example, the user could transfer into memory the contents of the entire disk or of just one or two songs if so desired for output to the listener wherein the user could continue to transfer more for example, one more song or the remaining contents of the disk." Preview devices like this were well known in the art at the time of the invention as stated in the obviousness claim. This is further evidenced by such art as Stern (U.S. 6,553,404). As such the claims remain rejected.

The rest of the arguments have been considered but are moot in light of the restriction and election

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bartley (U.S. 5,727,231), Tavana (U.S. 5,825,202), Chang (U.S. 5,687,325), and Faber (U.S. 3,878,514).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner states: The claims elected without traverse have either been rejected for a second time with new art due to amended limitations within the claim, or the previous rejections have stood on non-amended claims. Therefore, even in light of the restriction, no new grounds have been introduced and a Final Rejection is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (703) 305-0381. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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